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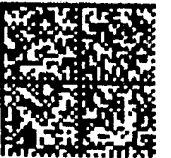
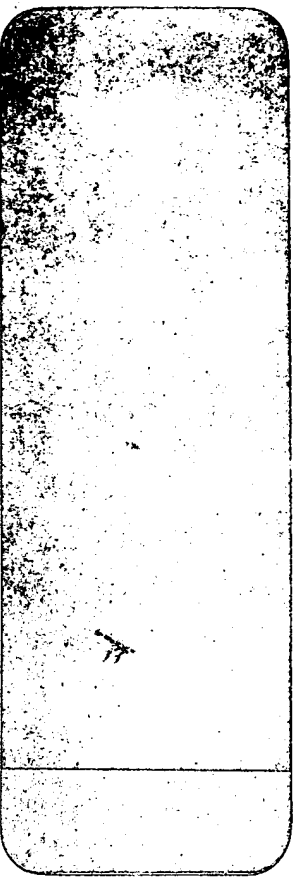
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IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER



UNITED STATES POSTAGE
PRIME BOWERS
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WELB331* 956162305 1703 06 08/23/04
FORWARD TIME EXP RTN TO SEND
WELBORN
3108 MERCED DR
DAVIS CA 95616-6759
RETURN TO SENDER



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,509	01/05/2001	Christopher Michael Welborn		5089

7590 08/18/2004
CHRISTOPHER MICHAEL WELBORN
331 SANDPIPER DRIVE
DAVIS, CA 95616

EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
2131	

2131

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

AUG 25 2004

Technology Center 2100

Office Action Summary	Application No. 09/755,509	Applicant(s) WELBORN ET AL.	
	Examiner Matthew T Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 January 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-49 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-49 is/are rejected.
- 7) Claim(s) 17 and 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 April 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/05/01.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

This action is in response to the communication filed on 01/05/2001.

DETAILED ACTION

1. Claims 1-49 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is January 5, 2001.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 01/05/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

6. The drawings filed on 04/05/2001 are acceptable for examination proceedings.

Specification

7. The use of numerous trademarks such as "MICROSOFT" and "WINDOWS" has been noted in this application. They should be capitalized wherever they appear and should be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required. See MPEP § 608.01(v).

Claim Objections

8. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

9. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 15 recites the limitation "the fourth computer" in line 1. There is insufficient antecedent basis for this limitation in the claim and the claim is therefore rejected.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

Art Unit: 2131

applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 1, 3-7, 19, 32-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatraman et al. (U.S. Patent Number 6,014,688) hereinafter referred to as Venkatraman.
14. Claim 1 recites an e-mail user behavior modification system for computer virus avoidance, an e-mail system with users each with an e-mail address and a first, second, and third computer in a computer network, wherein the e-mail user behavior modification system provides: means for a first computer to select a set of e-mail addresses from an e-mail directory (See Venkatraman Fig. 5 which depicts a list of multiple recipients wherein it was inherent that the recipients were selected in order for the list of recipients to have existed); means for the first computer to transmit the set of e-mail addresses to a second computer in the computer network (it was inherent that the list of recipients depicted in Fig. 5 of Venkatraman was sent to the computer used for e-mailing in order for the e-mail to be received by the recipient's in the list); means for the second computer to send an e-mail with a mock computer virus attachment to a user with an e-mail address in the set of e-mail addresses (See Venkatraman Col. 6 Paragraph 5 – Col. 7 Paragraph 1 wherein it was inherent that the e-mail was sent to the recipients in the list of recipients in order for the recipients to receive the e-mail as required by the system of Venkatraman); means for the mock computer virus attachment when opened by a user, to send an e-mail to the e-mail address of a third

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computer indicating that the mock virus attachment was opened by the user (See Venkatraman Fig. 15 Elements 136, 138, 144, 150, and 152, and Col. 8 Lines 27-30); means for the third computer to compile a list of users with e-mail addresses that opened the mock computer virus attachment (it was inherent that a list of addresses who triggered the event Element 136 was compiled via the receipt of return receipt e-mails in the specified addresses inbox).

15. Claim 6 recites that the first computer, the second computer, and the third computer are the same computer (See Fig. 1 Element 20 and Col. 8 Lines 27-30 wherein the sending computer received the receipts).

16. Claims 3-5 are rejected for the same reasons as claim 4 above.

17. Claim 7 recites that the list of users with e-mail addresses that opened the mock computer virus attachment is accessible as a web page or sent as an e-mail (See Venkatraman Col. 8 Paragraph 4).

18. Regarding claim 19, it was inherently natural that in having a list of users who accessed the attachment (See rejection of claim 1 above), the inbox also contained a list of users that did not access the attachment.

19. Claim 32 is rejected for the same reasons as claim 1 above, and further because Venkatraman disclosed the use of software to implement the e-mail system (See Venkatraman Detailed Description Paragraph 1).

20. Claims 33, 34, and 37 are rejected for the same reasons as claim 1 above.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over

Venkatraman as applied to claim 1 above, and further in view of Fischer (U.S. Patent number 5,311,591).

Venkatraman disclosed a system for sending e-mails with automatically executing attachments and automatic receipts (See rejection of claim 1 above), but failed to disclose the system requiring authorization in order to send the e-mails.

Fischer teaches that in order to prevent the spread of viruses, authorization should be provided prior to sending electronic mail (See Fischer Col. 13 Paragraphs 3-4 and Col. 3 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Fischer to the E-mail program of Venkatraman in order to authorize the sending of electronic messages. This would have been obvious because the ordinary person skilled in the art would have been motivated to prevent the unintentional spread of computer viruses.

23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman as applied to claim 1 above, and further in view of Moraes (U.S. Patent Number 6,014,502).

Venkatraman disclosed a system for sending e-mails with automatically executing attachments and automatic receipts (See rejection of claim 1 above), but failed to disclose determining of the number of recipients of the message.

Moraes teaches that in an e-mail system, advertisements can be displayed in e-mails and the number of viewers of an advertisement can be used to bill an advertiser (See Moraes Col. 6 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Moraes in the e-mail system of Venkatraman in order to display advertisements in e-mails. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the recipients with advertisements targeted toward their interests (See Moraes Col. 5 Paragraph 2).

24. Claims 2, 10-18, 20-31, 35-36, and 38-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Venkatraman and Moraes.

25. Regarding claim 2, Moraes disclosed sending the e-mails over the Internet (See Moraes Col. 3 Paragraph 6 and Col. 1 Paragraph 7).

26. Regarding claim 10, Moraes disclosed billing based on the number of viewers of an advertisement (See Moraes Col. 20 Lines 52-56).

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27. Claims 11 and 12 are rejected for the same reasons as claims 9 and 10 above.
28. Claims 13 and 14 are rejected for the same reasons as claims 9 and 10 above.
29. Regarding claim 15, Moraes disclosed targeting recipients with specific types of emails (See Moraes Col. 5 Paragraph 3).
30. Regarding claim 16, Moraes disclosed billing determined by the advertisements shown to users (See Moraes Col. 6 Paragraph 3).
31. Regarding claims 17 and 18, Moraes disclosed billing based on accesses to the event log and advertisement statistics file (See Moraes Col. 20 Lines 50-56).
32. Claim 20 is rejected for the same reasons as claim 10 above.
33. Regarding claims 21-23, Moraes disclosed changing the advertisements periodically (See Moraes Col. 5 Paragraph 6), and that the advertisements were chosen (authorized) for each user by the system (See Moraes Col. 7 Paragraph 3).
34. Regarding claim 24, Moraes disclosed billing based on the number of advertisements viewed (See Moraes Col. 6 Paragraph 4).
35. Claims 25-28 are rejected for the same reasons as claims 21-24 above.
36. Regarding claim 29, Moraes disclosed directly sending billing information over a network (See Moraes Col. 23 Paragraph 4).
37. Regarding claim 30, Moraes disclosed indirectly sending billing information over a network (See Moraes Col. 23 Paragraph 4).
38. Claim 31 is rejected for the same reasons as claim 18 above.
39. Claim 35 is rejected for the same reasons as claim 32 above and further because Moraes disclosed the providing the necessary software to the user over the Internet

(See Moraes Col. 10 Paragraph 7). It was inherent that a server provided the program in order for it to have been downloaded.

- 40. Claim 36 is rejected for the same reasons as claim 35 above.
- 41. Claims 38-49 are rejected for the same reasons as claim 35 above.

Conclusion

- 42. Claims 1-49 have been rejected.
- 43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Fischer (U.S. Patent Number 5,390,247) disclosed a system of traveling programs which e-mails itself to another address after being executed.
 - b. Coley et al. (U.S. Patent Number 5,826,014) disclosed a proxy firewall for regulating access to an e-mail or web server and a public network.
 - c. Birrell et al. (U.S. Patent Number 6,185,551) disclosed a web based e-mail system.
 - d. Flynn et al. (U.S. Patent Number 6,618,747) disclosed an e-mail system with delivery confirmation.
 - e. Veljkov et al. ("Pocket guide to the Internet Volume 4") disclosed background information about e-mail and the internet.

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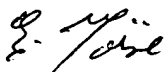
44. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (703) 305-0713. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
Assistant Examiner
Art Unit 2131



EMMANUELL L. MOISE
PRIMARY EXAMINER
A/d 2136

Notice of References Cited	Application/Control No. 09/755,509	Applicant(s)/Patent Under Reexamination WELBORN ET AL.	
	Examiner Matthew T Henning	Art Unit 2131	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-6,014,688	01-2000	Venkatraman et al.	709/206
B	US-5,311,591	05-1994	Fischer, Addison M.	713/156
C	US-6,014,502	01-2000	Moraes, Mark A.	709/219
D	US-6,618,747	09-2003	Flynn et al.	709/206
E	US-5,390,247	02-1995	Fischer, Addison M.	713/176
F	US-6,185,551	02-2001	Birrell et al.	707/3
G	US-5,826,014	10-1998	Coley et al.	713/201
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	Veljkov et al. "Pocket Guides to the Internet", 1994, Mecklermedia, Volume 4, pp 1 and 11
V	
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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	APPLICANTS	Christopher Michael Welborn and Kimberly Joyce Welborn
	FILING DATE	January 5, 2001
		GROUP

JC950 U.S. PTO
09/755509
01/05/01

REFERENCE DESIGNATION		U.S. PATENTS				
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS
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MTH	AB	5,121,345	June 9, 1992	Lentz	713	188
MTH	AC	5,319,776	June 7, 1994	Hile et al	713	200
MTH	AD	5,349,655	Sept. 20, 1994	Mann	714	006
MTH	AE	5,408,642	April 18, 1995	Mann	714	038
MTH	AF	5,421,006	May 30, 1995	Jablon et al	714	036
MTH	AG	5,440,723	Aug. 8, 1995	Arnold et al	714	002
MTH	AH	5,442,699	Aug. 15, 1995	Arnold et al	713	188
MTH	AI	5,452,442	Sept. 19, 1995	Kephart	714	038
MTH	AJ	5,475,839	Dec. 12, 1995	Watson et al	713	002
MTH	AK	5,485,575	Jan. 16, 1996	Chess et al	714	038
MTH	AL	5,509,120	April 16, 1996	Merkin et al	713	200
MTH	AM	5,511,163	April 23, 1996	Lerche et al	714	028
MTH	AN	5,511,184	April 23, 1996	Lin	710	261
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MTH	BD	5,918,008	June 29, 1999	Togawa, et al	713	200
MTH	BE	5,944,821	Aug. 31, 1999	Angelo	713	200
MTH	BF	5,956,481	Sept. 21, 1999	Walsh et al	713	200
MTH	BG	5,964,889	Oct. 12, 1999	Nachenberg	714	025
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MTH	BI	5,999,723	Dec 7, 1999	Nachenberg	703	022
MTH	BJ	6,016,546	Jan 18, 2000	Kephart et al	713	200
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MTH	BL	6,026,502	Feb 15, 2000	Wakayama	714	038
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MTH	BP	6,092,194	July 18, 2000	Touboul	713	200

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	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLAS	TRANSLATION	
						YES	NO

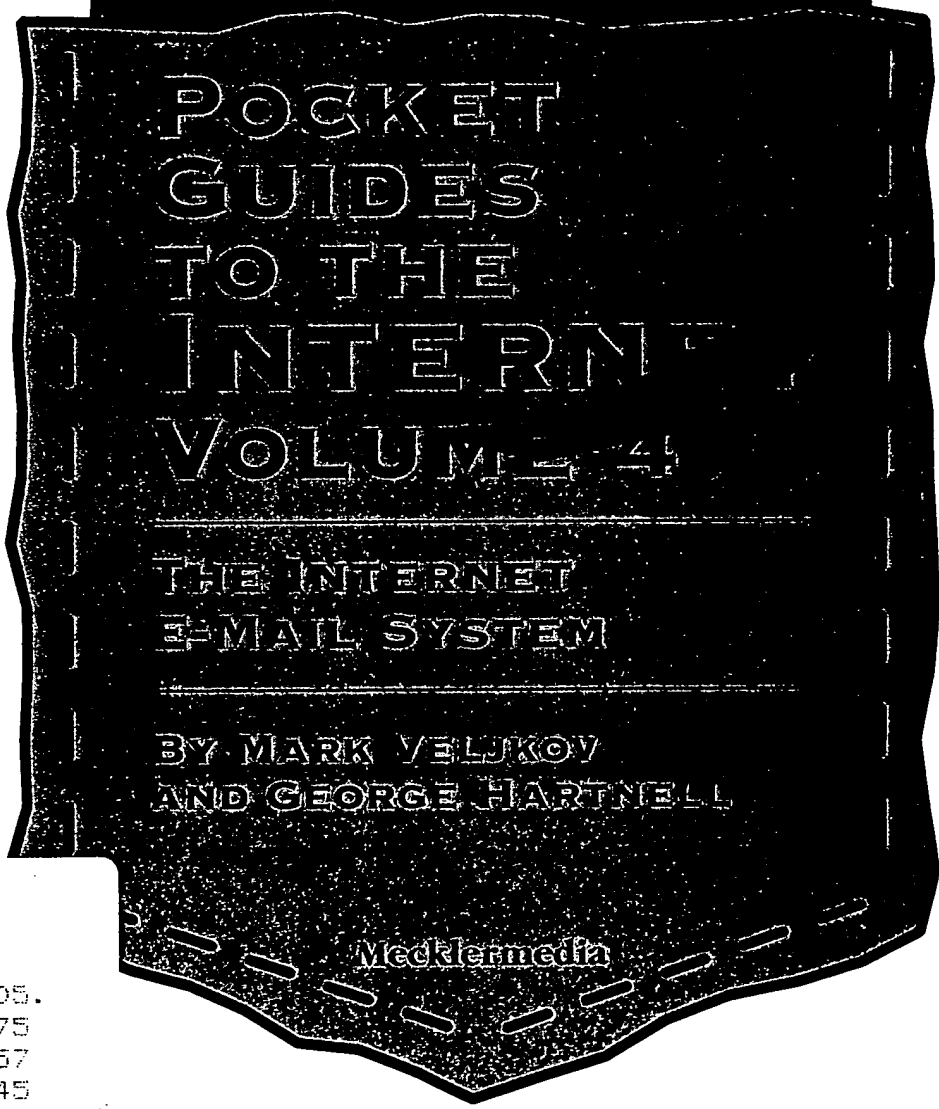
OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

EXAMINER		DATE CONSIDERED	7/30/04
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**EIC
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POCKET
GUIDES
TO THE
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VOLUME 4

THE INTERNET
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BY MARK VELJKOV
AND GEORGE HARTNELL

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CONTI

INTRODUCTION.....
Pocket Guides to the Internet.
How to Read These Guides....
Internet Prompts.....
Internet Addresses.....
Getting Help While Online.....
Types of Internet Connections
This Guide.....

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Using the Finger Command....
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Using Whois with E-Mail.....
Finding Users with the Usenet

CHAPTER 3: USING MAIL SERVI
What is a Mail Server?.....
Getting Help From a Mail Serv
Getting a File from a Mail Serv

CHAPTER 4: USING MAIL GATEW
What is a Mail Gateway?.....
How to Use a Mail Gateway: F
to a Foreign Network.....

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I. Internet (Computer network)--Handbooks, manuals, etc.

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INTRODUCTION

The Internet started with a large U.S. government network called ARPAnet. Today, the Internet has become a worldwide network of networks which interconnects many different computers ranging in size from the Macintosh and IBM-PC to sophisticated mainframes and supercomputers. This network of networks is used for many different purposes. People use the Internet to:

- retrieve free software;
- find and retrieve important documents;
- access library catalogs;
- carry on long distance relationships and conversations with other users;
- conduct research;
- connect to supercomputers; and
- many other activities too numerous to mention.

With all of this interconnecting of computers and networks, the Internet has become huge. In fact, no one is really sure just how big it has become. The Internet is made up of many types of computers, using a variety of operating systems such as DOS, UNIX, or VAX/VMS. These different computers and operating systems can all exchange data by connecting the different computers and computer networks with a standard set of communication procedures called protocols. On the Internet these protocols are called TCP/IP (Transmission Control Protocol/Internet Protocol).

In addition to these TCP/IP communication protocols, there are a variety of operating systems being used to control Internet hosts. The most common is the UNIX operating system which includes variations of UNIX such as XENIX, Apple Computer's A/UX,

CHAPTER 1

BASIC E-MAIL

WHAT IS E-MAIL?

Like mail you send to and receive from the post office, electronic mail, or e-mail, allows you to exchange messages with other people or services on the Internet. E-mail, of all Internet functions, will probably be the one Internet service that you use the most. You can communicate with your friends and colleagues, or just leave your opinion on one of thousands of special interest discussion groups. E-mail can be used for many other purposes as well, including:

- publishing;
- transferring documents;
- subscribing to other electronic services;
- finding computer software;
- getting answers to your technical questions; and
- engaging in electronic discussions on an unlimited range of topics.

HOW E-MAIL WORKS

Since there are similarities between e-mail and the way a postal system works, it may be beneficial to discuss e-mail by comparing it to a system you are already familiar with.

USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES

In support of its 21st Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) **provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions** via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) **cease mailing paper copies of U.S. patents and U.S. patent application publications with Office actions** (in applications and during reexamination proceedings) except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications during the international stage.

Schedule

June 2004	TCs 1600, 1700, 2800 and 2900
July 2004	TCs 3600 and 3700
August 2004	TCs 2100 and 2600

All U.S. patents and U.S. patent application publications are available on the USPTO web site. However, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible by phone at 866-217-9197 (toll-free), 703-305-3028 or 703-308-6845 or electronically via the Internet at ebc@uspto.gov.

Other Options

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide U.S. patents and patent application publications.

For complete instructions see the Official Gazette Notice, USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES, on the USPTO web site.

NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT REFERENCES

Summary

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site (www.USPTO.gov) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: http://www.uspto.gov/ebc/registration_pair.html.

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at eReference@uspto.gov or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

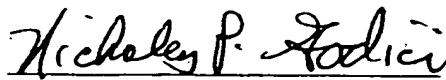
Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

Date. 12/1/03



Nicholas P. Godici
Commissioner for Patents